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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/723,240   | 11/26/2003  | James V. Howard      | P0910D              | 6031             |
| 23735 7590 10/09/2008<br>DIGIMARC CORPORATION<br>9405 SW GEMINI DRIVE<br>BEAVERTON, OR 97008 |             |                      |                     |                  |
| EXAMINER<br>STREGE, JOHN B   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 2624   |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/723,240

**Applicant(s)**

HOWARD ET AL.

**Examiner**

JOHN B. STREGE

**Art Unit**

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. The amendment received 7/14/08 has been entered in full.

***Response to Arguments***

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new grounds of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slocum et al. USPN 6,430,306 (hereinafter "Slocum") in view of Enright et al. USPN 6,583,813.

Regarding claim 1 Slocum discloses a system for issuing identification documents to a plurality of individuals (col. 1 lines 5-10, col. 5 lines 10-16), comprising: a first database, the first database storing a plurality of digitized images, each digitized image comprising a biometric image of an individual seeking an identification document (col. 6 lines 1-6 discloses a central image server 20 which stores the biometric image of a user attempting to obtain an identification document as well as an optional database memory 36); a first server which sends images to a biometric recognition system (20 of figure 1, col. 6 lines 1-6, discloses that the images collected by the acquisition unit may be stored either in the server 20 or a separate database 36), the biometric recognition

system in operable communication with a second database (as discussed in col. 9 lines 50-61 there is a verification module [read as a biometric recognition system] which is carried out in the data processor 34 [col. 7 line 66 – col. 8 line 11] which involves comparing the images stored in the server 20 which are sent to the verification module 34 at the predetermined time when an individual attempts to receive an identification card and the verification module is in operable communication with a second database 24 which is a demographic database), the second database including biometric templates associated with individuals whose images have been previously captured (col. 8 lines 10-38, and col. 9 lines 50-61); receive from the biometric recognition system, for the digitized image, an indicator, based on the biometric searching of the second database, as to whether the second database contains any images of individuals who may at least partially resemble the digitized image that was sent (col. 9 lines 50-61 discloses finding a projection signal [indicator] which is similar to the projection signal of the acquired image); and a workstation in operable communication with the first server, the workstation configured to permit a user to review the indicator and to make a determination as to whether the individual is authorized to be issued an identification document or to keep an identification document in the individual's possession (col. 10 lines 3-32).

As pointed out by the Applicant Slocum does not explicitly disclose a first server in operable communication with a first database the first server programmed to send, at a predetermined time, one or more digitized images from the first database to a biometric recognition system. Instead Slocum sends the image from the acquisition unit

directly to the biometric recognition system. However the idea of queuing images in a database which then sends the images to the recognition unit is not novel and would be obvious to one of ordinary skill in the art to modify Slocum to include a queue in a first database so that multiple images can be entered into a database and processed when the system is cleared up such as is common in a DMV environment.

Enright discloses a system for capturing and searching image data associated with transactions which allows images to be accessed and selectively processed and analyzed (col. 1 lines 9-16). Specifically Enright discloses capturing images on a continuous periodic basis and storing the images in a queue to be used for later image comparison (col. 18 lines 30-46).

Slocum and Enright are analogous art because they are from the same field of endeavor of image comparison.

At the time of the invention it would have been obvious to one of ordinary skill in the art to use the already existing database provided by Slocum (36 of figure 1), to queue images to be compared with images in the existing database such as taught by Enright. The motivation would be to allow for faster processing of clients by not having to wait for each transaction to clear before the next clients transaction can begin. Thus it would have been obvious to one of ordinary skill in the art to combine Slocum and Enright to obtain the invention of claim 1.

Regarding claim 2, the digitized image of Slocum is a facial image (col. 1 lines

5-

11).

Regarding claim 3, Slocum discloses that the identification document can be a driver's license (col. 5 line 45).

Regarding claims 4-5, Slocum discloses creating eigenvectors (biometric template) and providing the template to a recognition system (col. 8 lines 10-38).

Regarding claim 6, Slocum discloses comprising a list of data associated with individuals whose images at least partially resemble the digitized image that was sent (col. 10 lines 3-32).

Regarding claim 7, Slocum discloses a third database in operable communication with the workstation, the third database storing at least one of images and non-image data associated with each biometric template in the second database, wherein the workstation is configured to be able to retrieve information from the third database upon request and display it to a user (col. 9 lines 37-45).

Regarding claim 8, Slocum discloses wherein the indicator comprises a user interface, the user interface retrieving from the third database the images of at least a portion of the images of individuals that the biometric recognition system has determined may at least partially resemble the digitized image that was sent (col. 10 lines 3-32).

Regarding claim 9, Slocum discloses visually comparing the digitized image that was sent directly to an image of an individual whose data was returned in the indicator by the facial recognition search system (col. 10 lines 3-32).

Regarding claim 10, Slocum discloses a data acquisition element (22 of figure 1).

Claim 11 contains similar limitations to claim 1 addressed above thus only the differences will be discussed here. Claim 11 has the additional limitations that each match has a score, selecting from the second database those results having a score above a predetermined threshold and providing the results to a fourth database and providing the selected results to an investigator. As discussed above Slocum in col. 9 lines 47-61 discloses searching the official record database to identify any records having a projection signal similar to the projection signal of the acquired image. If the verification module determines that there is one or more very similar images the process proceeds to step 180 and displays these duplicate images. From this section it is inherent that the projection signal represents a score, and that the scores must be compared to a threshold in order to determine if they are "very similar or not". The section does not explicitly disclose that the results are provided to a fourth database, however it is well known that a system can have multiple databases in order to accommodate various different processes and that the images must be at least stored in a buffer or a database in order to display them. The decision to store these images in their own database would be a matter of design choice that would have no criticality on the function of the invention of Slocum. Slocum carries out the same process of determining whether or not an individual attempting to obtain an identification card is entitled to receive one, and one of ordinary skill in the art would view it as an obvious variation as to the number of databases that are used in the system to store the information. Thus at the time of the invention one of ordinary skill in the art would have modified Slocum in a design choice manner to obtain the invention of claim 11.

Regarding claim 12, the very similar images are displayed by Slocum (col. 9 lines 57-61).

Regarding claim 13, Slocum discloses storing the image and demographic data into an enforcement buffer within the data processor and can have a law enforcement official issue a citation to the applicant.

Regarding claim 14, Slocum discloses receiving an indicator from an investigator and repeating the steps (col. 10 lines 3-54).

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN B. STREGE whose telephone number is (571)272-7457. The examiner can normally be reached on Monday-Friday between the hours of 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Strege/  
10/07/08